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| 10/520,704 | 07/29/2005 | Jan De Kroon | 4662-302 | 2461 |
| 23117 7590 07/22/2008 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203 | | | | |
| EXAMINER | | | | |
| FREEMAN, JOHN D | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,704

Applicant(s)

DE KROON ET AL.

Examiner

John Freeman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

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DETAILED ACTION***Claim Objections***

1. Claim 1 is objected to because of the following informalities: "sued" in line 3 of the claim should read "used". Appropriate correction is required.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1 and 4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4 and 5 of copending Application No. 10/517595.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the applications describe multilayer structures that are substantially the same. The instant application claims a laminate comprising a substrate and a layer of Applicant's described polyamide polymer, which is substantially the same as a multilayer film comprising the same polyamide layer and another polymer layer as found in 10/517595.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nijenhuis et al. (WO 00/35992) in view of Cahill et al. (WO 99/15432).
2. Nijenhuis et al. (hereafter Nijenhuis) disclose randomly branched polyamides conforming to the formulae outlined by Applicant (p2 ln 29-p3 ln 32). The polyamides are suitable for films and molded articles (p7 ln 13).
3. Nijenhuis is silent, however, with regard to a laminate comprising said polyamides and its use in food packaging.
4. Cahill et al. (hereafter Cahill) disclose polyamides for use in film packaging (p4 ln 31). The polyamides may be branched polyamides made from multifunctional carboxylic acids and/or amines (p9 ln 10-19). Cahill suggests extruding the polyamide (p18 ln 8). The polyamides can be used as an inner coating for packaging, including those made of metal or glass (p25 ln 29). Other forms of acceptable packaging include that for candy (p27 ln 21). One of ordinary skill in the art would recognize that candy is often packaged in wrappers.
5. At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the branched polyamides of Nijenhuis in a laminate for foodstuffs packaging because one would have a reasonable expectation of success based on the previous use of branched polyamides in such packaging as exemplified by Cahill's disclosure.

Response to Arguments

6. Applicant's arguments filed 22 April 2008 have been fully considered but they are not persuasive.
7. Rejections of claim 5 under 35 USC 101 and 112 have been withdrawn in light of the cancellation of the claim.
8. Regarding the double patenting rejection, Applicant argues the present application is drawn to "a process in which a polyamide is applied to a solid substrate, whereas the invention of US10/517595 relates to a process producing a multilayer flat film" [original emphasis] (p5). The current claims of 10/517595 describe joining a polyamide layer to another polymer layer, i.e. a substrate. The examiner believes the other polymer is a solid. The rejected claims do not further qualify the identity of the substrate, and therefore encompass any substrate, including a polymer layer. Furthermore, there is no requirement that the substrate in the present claims 1 and 4 is solid. Also the claims of copending '595 do not require the process of extrusion, which also is not excluded by the present claims.
9. Regarding the rejection under 35 USC 103(a), Applicant argues that the present invention provides "a laminate comprising a substrate and a polyamide layer in which the polyamide layer can be coated on the substrate with a more uniform thickness" and suggests that a uniform thickness is achieved via use of a branched polyamide according to formulae (1)-(3) (p6). The examiner notes that no limitations of "uniform thickness" are found in the present claims. Furthermore, if Applicant submits that the use of the present branched polyamide provides the "uniform thickness", then the use of the polyamide in a laminate alone inherently provides such a thickness.
10. Applicant argues that Chaill does not teach of a link between uniform thickness and the present branched polyamide (p6). Therefore, Applicant further argues, there would be no reasonable expectation of success to use Nijenhuis's branched polyamide "to influence the thickness distribution when making a laminate" (p7). The examiner's argument does not rely on the ability of one of ordinary skill in the art to recognize the ability of Nijenhuis's branched polyamide to create a uniform thickness. Instead the examiner maintains that one of ordinary skill would recognize branched polyamides have been used in packaging applications in the past, Nijenhuis's branched polyamide is suitable for films, and therefore would reasonably expect Nijenhuis's branched polyamide would be suitable in a packaging laminate. The

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rejection stands. It is noted that "obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation", *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1966).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wang ('599) discloses highly branched polyamides suitable for use in food packaging.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Freeman whose telephone number is (571)270-3469. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Freeman
Examiner
Art Unit 1794

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